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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/821,729 | 03/28/2001 | Eriko Goto | 81754.0056 | 5473 |
| 26021 | 7590 | 11/04/2004 | EXAMINER | |
| HOGAN & HARTSON L.L.P. 500 S. GRAND AVENUE SUITE 1900 LOS ANGELES, CA 90071-2611 | | | DAVIS, ZACHARY A | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2137 | |
| DATE MAILED: 11/04/2004 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|--|--------------------------------------|------------------------------------|--|
| <p align="center">Office Action Summary</p> | Application No. 09/821,729 | Applicant(s) GOTO ET AL. | |
| | Examiner Zachary A Davis | Art Unit 2137 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☒ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) * | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>20011218</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Preliminary amendments were received on 31 August 2001 and 26 February 2002. Claims 1-19 have been amended. Claims 1-19 are pending in the present application.

Priority

2. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The Declaration does include the correct reference to Japanese Application No. 2000-092496. However, a certified copy of the Japanese application could not be found in the present application file. Therefore, the attached form PTOL-326 indicates that "Some certified copies of the priority documents have been received" in order to reflect this.

Specification

3. The disclosure is objected to because of the following informalities: The specification appears to contain typographical errors; for example, in the substitute specification, on page 16, line 4, it appears that "internal format 4" is intended to read "internal format 5"; on page 16, line 25, it appears that "sever 3" is intended to read "server 3"; and on page 18, line 21, it appears that "covert" is intended to read "convert".

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The specification also appears to contain grammatical errors; for example, the sentence beginning "As only data with mail format" on page 22, lines 1-3, appears to be a fragment. Appropriate correction is required. Applicant's cooperation is requested in correcting any other errors of which applicant may become aware in the specification.

Claim Objections

4. Claims 4 and 15 are objected to because of the following informalities: Claim 4 recites the limitation "a predetermined time of period" in lines 2-3 of the claim. It appears that this is intended to read "a predetermined period of time" or "a predetermined time period" or similar. Claim 15 recites the limitation "to storage data" in line 2 of the claim. It appears that this is intended to read "to store data".

Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "it" in line 7. It is unclear to what, specifically, this refers, although it appears to refer to the data with an internal format. This renders the claim indefinite.

Claim 4 recites the limitation "the database of the host computer" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 9 recites the limitation "the transmit process data storage means" in line 7 and the limitation "the transmit data storage means" in line 8. There is insufficient antecedent basis for these limitations in the claim.

Claim 10 recites the limitation "the sending process data storage means" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 15 recites the limitation "the transmit data storage means" in lines 15-16. There is insufficient antecedent basis for this limitation in the claim.

Claim 16 recites the limitations "the additional storage process", "the database", and "the host computer side" in lines 3-5 of the claim. There is insufficient antecedent basis for these limitations in the claim.

Claim 17 recites the limitation "a mail sending section to send mails through communication line to the mail server are arranged in the mail transfer section". This limitation is generally unclear, which renders the claim indefinite. For purposes of interpreting the prior art, it appears that the claim is intended to state that both the mail receiving section and the mail sending section are arranged in the mail transfer section.

Claim 19 recites the limitation “the network side” in line 2, “the host computer side” in line 3, and “the host computer” in line 8. There is insufficient antecedent basis for these limitations in the claim.

Claims not specifically referred to above are rejected due to their dependence on a rejected base claim.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 17-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Nishiyama et al, US Patent 5844691.

In reference to Claim 17, Nishiyama discloses a network security system including a server including a mail client and a mail server (column 17, lines 54-63, and column 18, lines 31-40), a mail transfer section including a mail receiving section and mail sending section (Figure 16, Email Transmission and Receiving Portion 2208, and Figure 17, Email Transmission and Receiving Portion 2308), and that a host computer receives data transfer from the server through the mail receiving section (column 17, line 64-column 18, line 3) and transfers data to the server through the mail sending section (column 18, lines 41-47).

In reference to Claim 18, Nishiyama discloses that the communication line is dedicated to mail (see Figure 16, elements 2208 and 2014, and Figure 17, elements 2308 and 2024).

In reference to Claim 19, Nishiyama discloses a network security system including a mail server (column 17, lines 54-63, and column 18, lines 31-40), a mail transfer section including a mail receiving section and a mail sending section (Figure 16, Email Transmission and Receiving Portion 2208, and Figure 17, Email Transmission and Receiving Portion 2308), and that a host computer receives data transfer from the mail server through the mail receiving section (column 17, line 64-column 18, line 3) and transfers data to the server through the mail sending section (column 18, lines 41-47).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nishiyama et al, US Patent 5844691, in view of Barlow, US Patent 5204961.

In reference to Claim 1, Nishiyama discloses a server (column 17, lines 54-60), a received data storage means (column 17, lines 64-67), and a received data format

conversion means (column 18, lines 3-7). Nishiyama also discloses a database for storing received, format-converted data (Figure 16, Data Base Portion 2203). However, Nishiyama does not explicitly disclose a host computer executing a process using the data with the internal format.

Barlow discloses a network security system including a received data storage means (Figure 3, Transport and Network Services 172), a received data format conversion means (Figure 3, Trust Realm Service Program 174; column 8, lines 44-49), and a host computer executing a predetermined process using the received, format-converted data (Figure 3, Receiving Application 186).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Nishiyama by including the host computer as taught by Barlow, in order to strengthen the trust between computers communicating over an insecure network by enforcing common security protocols for the protection of confidential data (see Barlow, column 2, lines 8-17).

In reference to Claims 2 and 3, Barlow further discloses that the communications are unidirectional between the server, received data storage means, received data format conversion means, received process data storage means, and host computer (see Figure 3, where the message 153 travels in one direction from the network 110 to the receiving application 186).

In reference to Claim 4, Nishiyama further discloses storing and sending data with a predetermined time period (column 18, lines 41-43 and 65-67).

In reference to Claim 5, Nishiyama further discloses executing processes in a lump sum manner (column 18, lines 18-23) and with independent timing (column 18, lines 41-43, and column 18, line 67-column 19, line 9).

In reference to Claim 6, Nishiyama further discloses that the data is converted to a database format (column 18, lines 3-7).

In reference to Claim 7, Nishiyama further discloses that the server sends data with a mail format (column 17, line 64-column 18, line 3).

In reference to Claim 8, Nishiyama further discloses sending data over the Internet (column 17, lines 64-67).

In reference to Claim 9, Nishiyama discloses a transmit process data storage means, a transmit data format conversion means (column 18, lines 41-47), and a server (column 18, lines 31-37). Nishiyama also discloses a database from which data, originally in an internal format, is sent (Figure 17, Data Base Portion 2303). However, Nishiyama does not explicitly disclose a host computer executing a process using data with an internal format.

Barlow discloses a network security system including a transmit data format conversion means (Figure 3, Trust Realm Service Program 156; column 7, lines 28-33), a transmit data storage means (Figure 3, Transport and Network Services 155), and a host computer executing a predetermined process using data with an internal format that is to be sent (Figure 3, Initiating Application 152).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Nishiyama by including the host computer as taught by Barlow, in order to strengthen the trust between computers communicating over an insecure network by enforcing common security protocols for the protection of confidential data (see Barlow, column 2, lines 8-17).

In reference to Claims 10 and 11, Barlow further discloses that the communications are unidirectional between the host computer, transmit process data storage means, transmit data format conversion means, transmit data storage means, and server (see Figure 3, where the message 153 travels in one direction from the initiating application 152 to the network 110).

In reference to Claim 12, Nishiyama further discloses executing processes with independent timing (column 18, lines 41-43, and column 18, line 67-column 19, line 9).

In reference to Claim 13, Nishiyama further discloses that the server receives data with a mail format (column 18, lines 41-47).

In reference to Claim 14, Nishiyama further discloses sending data over the Internet (column 17, lines 64-67).

In reference to Claim 15, Nishiyama discloses a received data storage means (column 17, lines 64-67), a received data format conversion means (column 18, lines 3-7), a transmit process data storage means, a transmit data format conversion means (column 18, lines 41-47), and a server (column 17, lines 54-60; column 18, lines 31-37). Nishiyama also discloses a database for storing received, format-converted data (Figure

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16, Data Base Portion 2203). However, Nishiyama does not explicitly disclose a host computer executing a process using the data with the internal format.

Barlow discloses a network security system including a received data storage means (Figure 3, Transport and Network Services 172), a received data format conversion means (Figure 3, Trust Realm Service Program 174; column 8, lines 44-49), and a host computer executing a predetermined process using the received, format-converted data (Figure 3, Receiving Application 186). Barlow further discloses a transmit data format conversion means (Figure 3, Trust Realm Service Program 156; column 7, lines 28-33) and a transmit data storage means (Figure 3, Transport and Network Services 155).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Nishiyama by including the host computer as taught by Barlow, in order to strengthen the trust between computers communicating over an insecure network by enforcing common security protocols for the protection of confidential data (see Barlow, column 2, lines 8-17).

In reference to Claim 16, Nishiyama further discloses executing processes with independent timing (column 18, lines 41-43, and column 18, line 67-column 19, line 9).

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Darland et al, US Patent 5793771, disclose a communication gateway that separates inbound and outbound communications, and uses a format conversion.
- b. Nemoto, US Patent 6032259, discloses a secure network server that provides for one-way communication between elements of the system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zachary A Davis whose telephone number is (571) 272-3870. The examiner can normally be reached on weekdays 8:30-6:00, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on (571) 272-3868. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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PRIMARY EXAMINER
Art Unit 2137